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PATENT

Attorney Docket No.: 015280-367200US
Client Ref. No.: E-232-1998/0-US-03

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

On February 28, 2005

TOWNSEND and TOWNSEND and CROWELL

By: Jeanne

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Wang et al.

Application No.: 10/600,158

Filed: June 20, 2003

For: METHODS FOR IDENTIFYING
INHIBITORS OF GADD45
POLYPEPTIDE ACTIVITY, AND
INHIBITORS OF SUCH ACTIVITY

Customer No.: 45115

Confirmation No. 5806

Examiner: CHISM, Billy D

Technology Center/Art Unit: 1654

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office communication mailed January 19, 2005, Applicants elect Group III, claims 12-18 and 29-37, drawn to a method for sensitizing proliferating cells to DNA base-damaging agents, for further prosecution. This election is made with traverse.

Basis for restriction practice is illustrated in 35 U.S.C. §121, "[i]f two or more independent and distinct inventions are claimed in one application, the Director [of the Patent and Trademark Office] may require the application to be restricted to one of the inventions." The meaning of "independent" and "distinct" is further provided by MPEP §802.01: the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed; the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part thereof, process, and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed.

The present application is based on the first illustration of the important role of GADD45 in G2/M checkpoint via its binding and inhibition of Cdc2/cyclin B. This discovery thus relates to, among other things, a screening method for identifying compounds capable of modulating GADD45 activity, and a method for sensitizing proliferating cells to DNA base-damaging agent by inhibiting GADD45 activity. The subject matter of the restriction requirement, particularly that of Groups I, II, and III, are closely related, as the GADD45 inhibitors identified by the screening method of Group I or II can be further used in the method for sensitizing proliferating cells by inhibiting GADD45 of Group III. Thus, the subjects upon which the restriction requirement is imposed are not "independent" under 35 U.S.C. §121 according to the MPEP's definition.

Nor are the subjects "distinct" under 35 U.S.C. §121 according to the MPEP's definition. Because the claimed method for sensitizing proliferating cells of Group III relies on the screening method of Group I or II, they cannot be separated from each other when the claimed method is practiced.

Because of the common inventive concept and the close relation between the subject matter of Groups I, II, and III, the examination of these Groups together would not impose any additional, unreasonable burden on the Examiner. Applicants respectfully submit that the restriction requirement is improper and request that the Examiner reconsider and withdraw the requirement. Since the claims in Group I have already been prosecuted and

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Resp. dated February 25, 2005
Reply to Office communication of January 19, 2005

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allowed in the parent case and thus were canceled in the preliminary amendment submitted on June 20, 2003, it is respectfully requested that claims of Groups II and III be examined together.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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